

ESTTA Tracking number: **ESTTA496407**

Filing date: **09/25/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91198552
Party	Plaintiff Raising Cane's USA, L.L.C.
Correspondence Address	S LLOYD SMITH BUCHANAN INGERSOLL & ROONEY PC PO BOX 1404 ALEXANDRIA, VA 22314 UNITED STATES bryce.maynard@bipc.com, lloyd.smith@bipc.com, bassam.ibrahim@bipc.com
Submission	Other Motions/Papers
Filer's Name	S. Lloyd Smith
Filer's e-mail	lloyd.smith@bipc.com
Signature	/S. Lloyd Smith/
Date	09/25/2012
Attachments	Answer to Amended Petition for Cancellation - 1032733-000078.pdf ( 9 pages (308999 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Fifty-Six Hope Road Music Limited,	:	
	:	
Petitioner,	:	
	:	
v.	:	Opposition No. 91198552 (parent)
	:	Cancellation No. 92053461
Raising Cane's USA, LLC.	:	
	:	
Registrant.	:	
	:	

**ANSWER TO AMENDED PETITION FOR CANCELLATION**

Registrant Raising Cane's USA, LLC ("Registrant"), hereby responds to the numbered allegations in Fifty-Six Hope Road Music Limited's ("Petitioner") Amended Petition for Cancellation.

1. Registrant admits that the registrations and applications cited in paragraph 1 and attached to the Amended Petition list Petitioner as the owner of the marks stated therein. Registrant lacks sufficient knowledge to form a belief as to Petitioner's ownership of these marks and any other rights associated with Bob Marley, and therefore denies the same. Registrant further denies that Petitioner has used the phrase "One Love" as a trademark on any of the items listed in this paragraph, that the purported MARLEY Marks and ONE LOVE Mark are a family of marks, and that the purported ONE LOVE mark has acquired secondary meaning and trademark rights in the United States and beyond.

2. Registrant lacks sufficient knowledge to form a belief as to the allegations in paragraph 2 and therefore denies the same.

3. Registrant denies that the name “One Love” has become widely associated with and points uniquely and unmistakably to Bob Marley’s identity and persona. Registrant lacks sufficient knowledge to form a belief as to the remaining allegations in paragraph 3 and therefore denies the same.

4. Registrant denies that Petitioner has made trademark use of ONE LOVE in connection with any goods or services prior to Registrant's first use and registration of ONE LOVE. Registrant lacks sufficient knowledge to form a belief as to the remaining allegations in paragraph 4 and therefore denies the same.

5. Registrant admits that its U.S. Registration No. 3,033,511 for ONE LOVE is valid and subsisting and speaks for itself with respect to the information contained therein. Registrant further admits that it is not connected to Petitioner and Bob Marley. Registrant lacks sufficient knowledge to form a belief as to the remaining allegations in paragraph 5 and therefore denies the same.

6. Registrant denies the allegations in paragraph 6.

7. Registrant denies the allegations in paragraph 7.

8. Registrant denies the allegations in paragraph 8.

9. Registrant admits that Registrant's U.S. Registration No. 3,033,511 for ONE LOVE ("ONE LOVE Mark") has been cited by the U.S. Patent and Trademark Office against Petitioner's U.S. Application Serial No. 77/782,232, and that Registrant has used the ONE LOVE Mark as a basis to oppose Petitioner U.S. Application Serial No. 77/549,263—ONE LOVE for services in Class 41. Registrant denies the remaining allegations in paragraph 9.

10. Registrant denies the allegations in paragraph 10.

11. Registrant denies the allegations in paragraph 11.
12. Registrant denies the allegations in paragraph 12.

Registrant further denies that Petitioner is entitled to the relief requested.

### **AFFIRMATIVE DEFENSES**

#### **Introduction**

Registrant has used its ONE LOVE mark in interstate commerce in the United States since at least as early as 2001. Petitioner has been on constructive notice of Registrant's rights in its ONE LOVE Mark since at least as early as the March 4, 2004 filing date of Petitioner's U.S. Registration No. 3,033,511. Accordingly, Petitioner knew or should have known of Registrant's use for years yet failed to take any action in relation thereto. More recently, Registrant engaged in good faith discussions with Petitioner to allow for peaceful co-existence and has invested substantial time and resources to that end.

Registrant adopted its ONE LOVE Mark in good faith. As Registrant expanded, Registrant's founder, Todd Graves, in connection with others, began looking for a brand element for the company like brand elements used by other businesses in the restaurant industry. Registrant's core competitive advantage is serving a focused product, chicken fingers. Registrant desired a slogan that referred back to the company's focused product, chicken fingers, and included the word ONE. At the time, Managers in the companies used "ONE LOVE" to sign off on emails and at the close of end of shift communication. Registrant was also starting to refer to its unique award-winning respect, recognition and rewards program as Cane's Love, which is an ultimate expression of how company crewmembers treat each other. The program began in the first year of company operations and has continued & evolved to be an essential element of the

brand and company culture. Thus, the ONE LOVE slogan was chosen. Registrant never thought about or discussed Bob Marley.

Registrant's extensive use of its ONE LOVE Mark over the past decade in connection with its chicken fingers restaurants has been ubiquitous. Registrant has 137 locations in 17 states, including Louisiana, Mississippi, Texas, Alabama, Georgia, Virginia, Nebraska, Colorado, Kentucky, Massachusetts, Minnesota, Oklahoma, Ohio, South Carolina, Nevada, Arizona, and New Jersey, and continues to expand. Registrant's ONE LOVE Mark fits its vision to have locations all over the world and be known as the brand for quality chicken finger meals, a great crew, cool culture and active community involvement. Every day, over 3500 crewmembers work to meet the company mission: serving the perfect box, fast, friendly, clean and have fun. Registrant's ONE LOVE Mark further coincides with its active community involvement, which is not only part of the Company vision but also a part of the Brand DNA as Registrant owes its success to the communities that support it. Registrant's five focus areas in active community involvement are education, feeding the hungry, Cane-9 assistance, active lifestyles and business development/entrepreneurship. Registrant supports over 150 education institutions, 25 food banks, 25 pet welfare societies, 100 active lifestyle opportunities and 75 professional organizations in the communities in which the company does business.

Registrant's usage of its ONE LOVE Mark includes, but has not been limited to, exterior wall murals, packaging, tiling in its restaurant entrances, uniforms, billboards, radio commercials, television commercials, print advertisements, wrapping commuter buses, Registrant's website, business cards, twitter, every company email footer, letterhead, stationary, promotional folders and menus. As a result, Registrant's ONE LOVE Mark has significant

awareness and association with consumers.

Mr. Graves has been recognized for his entrepreneurial spirit in *Nation's Restaurant News*, *Chain Leader*, *QSR*, *Entrepreneur*, *Rolling Stone* and *USA Today*. He has appeared live on FOX News Network's "Your World" with Neil Cavuto and "FOX and Friends" and was highlighted on CNN Headline News's "Pulse on America" series. Mr. Graves was featured in *Entrepreneur's* Young Millionaires cover story. In 2008, Mr. Graves was named an Ernst & Young "Entrepreneur of the Year" and in 2010 he was awarded the SCORE Award for Outstanding Socially Progressive Business. Mr. Graves was also featured on a nationally televised episode of "Secret Millionaire".

Registrant was honored as an "Emerging Concept" at the Elliot Conference in New York in 2002 and was chosen as a "Hot Concepts!" award winner by *Nation's Restaurant News* in 2003. In 2006, Registrant received the National Restaurant Association's Good Neighbor Award. In 2007, Mr. Graves was recognized as one of the "Top 100 Movers and Shakers" by *Fast Casual* magazine. Registrant was also named to *Inc. Magazine's* top 5000 list of fastest growing privately-owned companies, earning the 1,048th spot in 2007 and the 1,610th spot in 2008. Registrant also earned a spot on the list of fastest-growing companies in the food and beverage industry, earning the 15th spot in 2007 and the 35th spot in 2008. Registrant ranked second overall in the state of Louisiana.

Also in 2008, Registrant ranked number 233 in *Restaurants and Institutions'* "Top 400 Restaurant Chains" list. Registrant received the "Best Places to Work" recognition in *Chain Leader* magazine in 2007. For 2010, Raising Cane's was ranked #4 in the nation for Overall Customer Satisfaction by Sandelman and Associates. In the company's home market of Baton

Rouge, Louisiana, Raising Cane's ranked #2 in Overall Customer Service ranking second to Ruth's Chris Steakhouse and beating Flemings Steakhouse. The *Dallas Morning News* ranked Raising Cane's a Top 100 place to work for two years running.

Based on all of the above, Registrant and its ONE LOVE Mark have become associated with high quality and outstanding community service and spirit.

Estoppel

13. Petitioner's claims against Registrant are barred under the doctrine of estoppel.

Waiver

14. Petitioner's claims against Registrant are barred under the doctrine of waiver.

Acquiescence

15. Petitioner's claims against Registrant are barred under the doctrine of acquiescence.

Laches

16. Petitioner's claims against Registrant are barred under the doctrine of laches.

Unclean Hands

17. Petitioner's claims against Registrant are barred under the doctrine of unclean hands.

Dissimilar Marks

18. Petitioner's marks BOB MARLEY and BOB MARLEY AND THE WAILERS are so dissimilar from Registrant's ONE LOVE Mark there is no likelihood of confusion as a matter of law.

### Priority

19. Petitioner does not have priority of use and Petitioner cannot meet its burden of proof in establishing trademark use of the mark ONE LOVE prior to Registrant's use of its ONE LOVE Mark. Petitioner's U.S. Trademark Application Serial Nos. 77/782,232 and 77/549,263 for ONE LOVE, in International Classes 43 and 41 respectively, were filed as intent to use applications, on July 16, 2009 and August 18, 2008 respectively. These applications, and the signed declarations that accompany them, constitute admissions that Applicant has not used its ONE LOVE mark in connection with the goods or services therein prior to their filing dates. Petitioner's U.S. Trademark Application Serial No. 77/233,644 for ONE LOVE in International Class 21, on its face, does not establish a priority date earlier than July 19, 2007. None of these dates is prior to Registrant's March 4, 2004 registration date for its U.S. Registration No. 3,033,511.

### No Fame

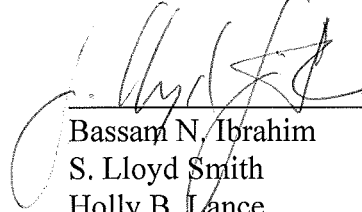
20. Registrant's use of ONE LOVE is not likely to cause dilution of any famous or distinctive mark allegedly owned by Petitioner within the meaning of 15 U.S.C. § 1125(c). Petitioner's alleged ONE LOVE mark did not become famous as a source identifier in connection with the alleged goods or services prior to Registrant's first use of ONE LOVE.



Date: 9/25/12

Respectfully submitted,

**RAISING CANE'S USA, LLC**

A handwritten signature in black ink, appearing to read "Bassam N. Ibrahim", is written over a horizontal line.

Bassam N. Ibrahim

S. Lloyd Smith

Holly B. Lance

Attorneys for Registrant

Buchanan Ingersoll & Rooney, PC.

1737 King Street

Suite 500


Alexandria, Virginia 22313-1404

(703) 836-6620

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing ANSWER TO AMENDED PETITION FOR CANCELLATION was served this 25th day of September, 2012 by first-class mail, postage prepaid, on:

Jill M. Pietrini  
Paul Bost  
Sheppard Mullin Richter & Hampton LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067

  
Florie Goodman